

ESTTA Tracking number: **ESTTA176166**

Filing date: **11/21/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	P. J. Valckenberg GmbH
Granted to Date of previous extension	11/21/2007
Address	Weckerlingplatz 1 D-67547 Worms am Rhein, GERMANY

Attorney information	Richard J. McKenna Foley & Lardner LLP 777 E. Wisconsin Ave Milwaukee, WI 53212 UNITED STATES ptomailmilwaukee@foley.com
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Applicant Information

Application No	78974638	Publication date	07/24/2007
Opposition Filing Date	11/21/2007	Opposition Period Ends	11/21/2007
Applicant	Phicon Investment Holdings (Pty) Ltd 20 Greyton Road Milnerton, SOUTH AFRICA		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Alcoholic beverages, namely, wines, distilled spirits, liqueurs, and brandy
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MADONNA		
Goods/Services	wines and wine glasses		

Related Proceedings	Opposition No. 91166355
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Attachments	Notice of Opposition 11-21-07.pdf (6 pages)(908357 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/tschulz/
Name	Tricia L. Schulz
Date	11/21/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of App. Serial No.: 78/974,638
Mark: MADONNA (stylized)
Published: July 24, 2007

P.J. Valckenberg GmbH)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
Phicon Investment Holdings (Pty) Ltd)	
Applicant.)	
)	

BOX TTAB/FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer, P.J. Valckenberg GmbH ("Valckenberg"), a limited liability company of the Federal Republic of Germany, having a business address at Weckerlingplatz 1, 67547 Worms am Rhein, Federal Republic of Germany, believes that it will be damaged by, and hereby opposes registration of the stylized mark MADONNA that is the subject of Application Serial No. 78/974,638 (the "Application") published in the *Official Gazette* on July 24, 2007 (and subject to two timely requests for extension of time to oppose, the second of which expires on November 21, 2007) and requests that registration of the Application be refused.

As grounds in support of this opposition, Opposer asserts as follows:

1. By the application herein opposed, Applicant seeks to register a stylized version of the word "MADONNA" as a trademark for "alcoholic beverages, namely, wines, distilled spirits, liqueurs and brandy," basing such application on an alleged intent to use such mark in commerce.

2. Opposer asserts that it is the owner of all right, title and interest in and to the mark MADONNA for wines and wine glasses. In the alternative, Opposer asserts that, as determined by the Board in its decision in Opposition No. 91166355 wherein Opposer opposed the registration of the mark MADONNA in standard characters sought by Applicant in its application Serial No. 78/368,528, Opposer is the owner of all right, title and interest in and to the mark MADONNA for wines.

3. The MADONNA mark was first used by Opposer in U.S. commerce at least as early as 1956 in connection with wines and wine glasses, and has been continuously used since then to the present in connection with the sale and offering for sale of Opposer's goods in U.S. commerce. In the alternative, Opposer asserts that, as determined by the Board in its decision in Opposition No. 91166355 wherein Opposer opposed the registration of the mark MADONNA in standard characters sought by Applicant in its application Serial No. 78/368,528, the MADONNA mark was first used by Opposer in U.S. commerce at least as early as 1981 in connection with wines, and has been continuously used since then to the present in connection with the sale and offering for sale of Opposer's goods in U.S. commerce.

4. The MADONNA mark is of significant value to Opposer as an identification of source in connection with the sale and offering of Opposer's goods.

5. Opposer has been using its MADONNA mark in connection with its goods since prior to any date on which Applicant may rely on in this proceeding, and in particular, has been using such mark since long prior to the filing date of the application opposed herein.

6. The MADONNA mark for Opposer's goods and the stylized MADONNA mark as sought to be registered by Applicant for Applicant's goods are identical or virtually identical in sound, spelling, connotation and commercial impression.

7. Applicant's intended goods and Opposer's goods are identical in part, and are closely related in part. The respective goods are typically offered and provided to the same classes of purchasers through the same channels of trade.

8. Applicant's MADONNA mark so resembles Opposer's MADONNA mark that when applied to the goods set forth in the Application, it will cause confusion, mistake or deception.

9. Through long use by Opposer of its MADONNA mark for Opposer's goods, purchasers and prospective purchasers of such goods, and/or related goods and services, associate such mark with a single source, namely, the Opposer.

10. Purchasers and prospective purchasers familiar with Opposer's goods identified by the MADONNA mark are likely to be misled into believing, contrary to fact, that Applicant's goods sold under the mark opposed herein emanate from or are in some way sponsored by Opposer, all to Opposer's irreparable damage through impairment of its goodwill, as symbolized by Opposer's mark.

11. Granting the registration sought by Applicant through the Application herein opposed would inhibit Opposer in its free use of its MADONNA mark in selling its products, which

would work manifest damage upon Opposer. Such registration would constitute *prima facie* evidence of an exclusive right to use the designation "MADONNA" for the goods designated in the Application and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of Opposer.

12. For at least the above reasons, registration of Applicant's Serial No. 78/974,638 is herein opposed on the grounds that Applicant's proposed MADONNA mark so resembles Opposer's MADONNA mark as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act, and under state statutory and common law.

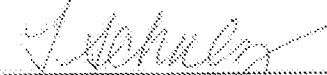
13. Based upon the Applicant's involvement in Opposition No. 91166355, Applicant and its counsel had direct knowledge of Opposer's prior rights in the U.S. in the MADONNA mark as used in connection with wines, and therefore knew or should have known that it made material misrepresentations of fact in the Declaration for application Serial No. 78/974,638 filed with the Patent and Trademark Office on September 14, 2006, when it stated that it believed it the "applicant to be entitled to use such mark in commerce" and that to the best of Applicant's knowledge and belief "no other person, firm, corporation, or association has the right to use the mark in commerce." As such, registration of Applicant's Serial No. 78/974,638 is herein opposed on the ground that Applicant committed fraud upon the Patent and Trademark Office in filing application Serial No. 78/974,638.

WHEREFORE, Opposer requests that this opposition be sustained and the subject application Serial No. 78/974,638 to register the stylized mark MADONNA be refused registration.

Payment in the amount of \$300.00 is tendered herewith via a credit card charge to cover the statutory filing fee. 37 C.F.R. § 2.6(a)(17). If any additional fees should be required, please charge the same to Deposit Account No. 19-0741.

Date: 11/21/07

Respectfully submitted,
FOLEY & LARDNER LLP

By: 
Richard J. McKenna
Tricia L. Schulz
777 E. Wisconsin Ave.
Milwaukee, Wisconsin 53202-5367
(414) 271-2400
Counsel for Opposer

CERTIFICATE OF SERVICE

I, Angelina Renteria hereby certify that a copy of the NOTICE OF
OPPOSITION was deposited with the United States Postal Service as first class mail, postage
prepaid, in an envelope addressed to:

Brewster Taylor
Brewster Taylor Stites & Harbison, PLLC
1199 North Fairfax Street
Suite 900
Alexandria, VA 22314-1437

Dated: 07/21/07

Signed: Angelina Renteria